

REMARKS

In the Office Action, the Examiner repeated the previous provisional rejection for double patenting over claims 1-53 of copending application 10/505,392.

The applicant believes that this rejection is premature because no claims have been allowed in Serial No. 10/505,392. Upon the indication of allowable subject matter, a terminal disclaimer will be filed.

In the Office Action, claims 1-4, 6-15, 17-26, 28-37, 39-48, 50-59, 61-70, 72-81, 83-88 and 97-102 were rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Caputo.

Reconsideration is requested.

The Egan patent has been cited as relating to an article of manufacture (figure 6) comprising a first support layer of film (1+2) with adhesive (19) permanent bond interface, a second film (13) that is adhesively secured to the lower surface of the first film at the permanent adhesive bond but having a separable interface between the adhesive and the release coat of film (13) and a third substrate (33) laminated to the upper surface of the first layer with adhesive (37).

The Egan patent at col. 9, lines 30-68 describes the use of a coating containing a release agent such as a silicone that is printed on a pattern such as is disclosed in Figs. 19-21. The application of a release layer results in decreased adhesion and does not in any way increase the adhesion of a surface. The selective application of a silicone release layer does not increase the adhesion of the

untreated layer when the silicone is applied in a pattern as shown by Egan.

Applicants' independent claims, 1, 12, 23, 45, 56, 67, 78 and 97, recite that the selective surface treatment that is used by the applicant is a corona, flame, plasma or combination thereof treatment. That treatment increases the adhesion selectively in the treated areas rather than selectively decreasing the adhesion. The application of a liquid release coating does not make obvious the use of physical means that are selectively applied in a pattern where it will increase adhesion where applied. Claim 1 and the other independent claims point out that adhesion is increased selectively while Egan selectively decreases adhesion using a silicone release coating. Egan uses a thermal adhesion system as pointed out at col. 9, line 64. Claim 1 and the other independent claim recite that the first thin film and second film layer are adhesively secured to one another. Nothing in Egan suggest the use of an adhesive layer at this point as Egan only teaches the uses of a thermal bonding procedure where the thermal bond is weakened by a silicone coating. In the present specification, the problem of edge lifting and the use of enhanced adhesion treatments to avoid this problem is disclosed at page 32, beginning at line 21, where it was disclosed that the present invention produced areas of easy separation and tight separation where the coupon or label was held during normal handling before removal by a consumer. This result is achieved using an adhesive layer under the removable coupon or label without the need to use the thermal bonding system of Egan. The precise positioning

of a liquid coating, in a pattern, is quite difficult as liquids tend to move before being immobilized by curing or drying and this problem is avoided by the non-liquid treating techniques recited in the claims of the present application.

Caputo was applied as teaching the application of no surface treatment in some areas and surface treatment in other areas by corona treatment and the Examiner concluded that it would be "obvious to have provided selective treatment on a surface in Egan in order to enhance adhesion as taught by Caputo et al.".

The Examiner is asked to consider that while Caputo is concerned with increasing adhesion under all of the area to be contacted with a tab, Egan is concerned with decreasing adhesion using a silicone coating to prevent complete unremovability of the label because of a tight bond due to a thermal bonding step as noted above. If the Caputo teaching of corona treatment was applied to the Egan substrate in place of the silicone release coating, the bonding would be increased and the contrary effect of the silicone coating would be obtained. Claims 1, 23, 34, 45, 56, 67 and 78 have been amended to point that the process results in a removable piece that is removable as disclosed in the specification at page 8, lines 18-20. This recitation makes it clear that coupon or label is removable even though a pattern of a treated area is applied under a removable coupon or label. Caputo applies a corona treatment to all of the surface of the area that is contacted with the adhesive. This non-selective corona treatment does not suggest the making of a pattern of treated and untreated areas to a

diecut piece as recited in claims 23, 34, 45, 56, 67 and 78 of the present application. An example of this language appears in claim 1 at lines 25-28.

Since there is no reason to combine Egan and Caputo together other than the applicants' specification and even when these references are considered alone or in combination, they fail to make the amended claims obvious. For these reasons, it is requested that this ground of rejection be withdrawn.

Claims 89-96 were again rejected under 35 U.S.C. §103(a) as being unpatentable over Egan in view of Caputo and further in view of Grabau.

Reconsideration is requested.

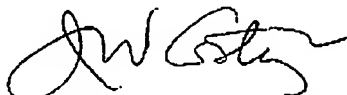
The Egan and Caputo references have been distinguished above based on the variable adhesion that has been achieved by a distinctly different approach that avoids the Egan coating process to place a patterned coating on a surface in some area while leaving other areas uncoated.

Grabau is concerned with the concept of embedding an RFID device in a label but it does not disclose the concept of providing one type of interface between one face of an adhesive layer and a different interface between the opposite face of the adhesive layer. The Egan patent has been distinguished above from the claims of the present application and nothing in Grabau provides any information that suggests the particular structure that is pointed out in claims 89-96. No reason for combining the cited references is found in the cited references as the references do not contain any teaching that would suggest the claimed subject matter without reference to the

applicant's disclosure For these reasons, it is requested that this ground of rejection be withdrawn.

An early and favorable action is earnestly solicited.

Respectfully submitted,



James V. Costigan
Registration No. 25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989